



-1083

Case Docket No. UNSYD 39709

Date: July 17, 1997

In re application of: JOHNSTON WILLIAM McAVOY and CORAL GWENDA CHAMBERLAIN

Serial No.: 08/648,092

Filed: May 17, 1996

For: A METHOD FOR PREVENTING OR CONTROLLING CATARACT

ASST. COMMISSIONER OF PATENTS

Washington, D.C. 20231

12

Sir:

Transmitted herewith is an amendment in the above-identified application:

- ☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.
- ☒ No additional fee is required.

The fee has been calculated as shown below:

	COL. (1)		COL. (2)		COL. (3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR		PRESENT EXTRA
TOTAL	* 25	MINUS	** 25		* - 0 -
INDEP.	* 5	MINUS	*** 5		* - 0 -
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					

SMALL ENTITY	
RATE	FEE
X \$ 11	\$
X \$ 40	\$
+ \$ 130	\$
1 MO. EXT. \$ 55	\$
2 MO. EXT. \$ 195	\$
3 MO. EXT. \$ 465	\$
TOTAL ADDL. FEE	\$

OTHER THAN A SMALL ENTITY	
RATE	ADDITIONAL FEE
X \$ 22	\$
X \$ 80	\$
+ \$ 260	\$
1 MO. EXT. \$ 110	\$
2 MO. EXT. \$ 390	\$
3 MO. EXT. \$ 930	\$
TOTAL ADDL. FEE	\$

- \* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- \*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
- \*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.
- The "Highest Number Previously Paid For" (Total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

☐ Please charge my Deposit Account No. 06-2425 the amount of \$\_\_\_\_\_. A duplicate of this sheet is enclosed.

☐ A check in the amount of \$\_\_\_\_\_ to cover the filing fee is enclosed.

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 06-2425. A duplicate copy of this sheet is enclosed.

☐ Any additional filing fees required under 37 CFR 1.16.

☒ Any patent application processing fees under 37 CFR 1.17.

FULWIDER, PATTON, LEE &amp; UTECHT, LLP

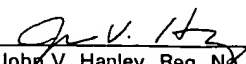
ATTORNEYS AT LAW

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10877 Wilshire Boulevard, Tenth Floor

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Respectfully submitted,

  
John V. Hanley, Reg. No. 38,171



I hereby certify that this correspondence is being deposited  
with the United States Postal Service as First Class Mail in  
an envelope addressed to the Assistant Commissioner for  
Patents, Washington, D.C., on July 17, 1997.

By: John V. Hanley  
John V. Hanley, Registration No. 38,171

Date of Signature: July 17, 1997

PATENT  
Docket No. UNSYD 39709

1205  
#9/c  
8-14-97  
D. Hanley

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	) Examiner: Z. Fay
Johnston William McAvoy	)
and Coral Gwenda Chamberlain	)
	)
SERIAL NO.: 08/648,092	) Group Art No.: 1205
	)
FILED: May 17, 1996	) July 17, 1997
	) Los Angeles, CA 90024
TITLE: A METHOD FOR PREVEN-	)
TING OR CONTROLLING	)
CATARACT	)
	)

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

AUG 12 1997

Dear Sir:

In response to the Office action dated June 18, 1997, Applicants hereby elect,  
with traverse, Group 1, claims 14-23 and 34-38, for examination. Also enclosed herewith  
is a copy of the Subsequent Preliminary Amendment filed on May 22, 1996. Claims 14-38  
remain pending.

In the June 18, 1997 Office action, claims 35-38 were not considered by the Examiner. As noted above, these claims were added to this application on May 22, 1996. Since each of claims 35-38 depend from claim 34, and since claim 34 was identified as belonging to Group 1, it is believed that the Examiner would have designated claims 35-38 as Group 1 claims. Accordingly, Applicants have included claims 35-38 in the group of claims being elected with traverse.

It is respectfully submitted that the claims of Group 1 (claims 14-23 and 34-38), as well as those of Group 2 (claims 24-28) and Group 3 (29-33), are not drawn to the treatment of different conditions and do not seek results which differ depending upon the disease condition that is being treated.

A cataract is a condition in which lens cells behave abnormally and give rise to opacification of the lens. This opacification impairs vision by preventing light from reaching the retina. Each of pending claims 14-38 address a common condition and are seeking a common outcome, that is, to preserve sight by maintaining the transparency of lens tissues.

Aftercataract, or posterior capsule opacification, is clearly a type of cataract or "a cataract-like disorder." Like other types of cataracts, it is known to arise by aberrant behavior of lens cells and is associated with the formation of cataractous opacities that impair vision. Moreover, the opaque regions show many of the features of other types of cataract.

This understanding of the close relationship between aftercataract and other types of cataract was common knowledge to those skilled in the art in the relevant timeframe.

Indeed, the summary set forth in the specification at page 13, lines 20-24 indicates that aftercataract is a type of cataract, since the list of references used to support the statement "These TGFB-induced responses are characteristic of the changes reported to occur during formation of various types of cataracts" includes a classical study of "opacification of the posterior capsule," that is aftercataract.

Furthermore, Applicants respectfully submit that since cataracts are diseases of the eye and are, therefore, diagnosed and treated by ophthalmologists, one practicing the invention of one of the claim groups defined by the Examiner, would indeed necessarily be required to practice the other defined groups. That is, because aftercataract is a type of cataract, ophthalmologists skilled in the art of diagnosing and monitoring the progression of primary cataracts would be expected also to be skilled in the subsequent diagnosis and treatment of any aftercataracts that may form following cataract surgery. They would also be expected to keep fully informed about any new treatments designed to prevent or retard cataract formation. Such an ophthalmologist, with knowledge about both cataract and aftercataract, would also be required to carry out cataract surgery and insert the lens implant.

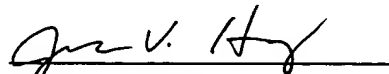
Accordingly, it is respectfully submitted that this application should not be restricted to Group 1, Group 2 or Group 3 claims, but rather, examination of this application should proceed in respect of each of Group 1, Group 2 and Group 3 claims.

**CONCLUSION**

Applicants have attempted to make a complete response to the outstanding Office action. In view of the above remarks, Applicants believe that the election/restriction requirement has been obviated and therefore respectfully request that examination of this application proceed in respect of each of pending claims 14-38.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
DESIGNATED/ELECTED OFFICE (DO/EO/US)

IN RE THE APPLICATION OF:	)	
Johnston William McAvoy	)	
and Coral Gwenda Chamberlain	)	
	)	
SERIAL NO.:	)	Docket No.: UNSYD 39709
	)	
FILED:      May 17, 1996	)	
	)	
INTERNATIONAL APPLICATION	)	
NO. PCT/AU94/00694	)	
	)	
INTERNATIONAL FILING DATE:	)	
11 November 1994	)	
	)	
PRIORITY DATE:	)	
19 November 1993	)	May 22, 1996
	)	Los Angeles, CA 90024
FOR: A METHOD FOR	)	
PREVENTING OR	)	
CONTROLLING CATARACT	)	
	)	

SUBSEQUENT PRELIMINARY AMENDMENT

Hon. Commissioner of Patents and Trademarks  
BOX PCT  
Washington, D.C. 20231

Attention: DO/EO/US

Dear Sir:

    This Subsequent Preliminary Amendment is being filed in connection with the above-referenced application. In addition to the amendments set forth in the Preliminary Amendment filed concurrently with the completion of the PCT National Phase filing of this case, please enter the following further amendments prior to examination of the application:

**IN THE CLAIMS:**

Please add the following new claims:

*Sub*  
*Fig*  
*D* --35. The use according to claim 34 wherein the inhibitors of TGF $\beta$  are selected from proteins, <sup>*glycoprotein*</sup> ~~glycoproteins~~ and proteoglycans.--

--36. The use according to claim 35 wherein the protein inhibitors of TGF $\beta$  are selected from antibodies and peptide growth factors.--

*C1* --37. The use according to claim 35 wherein the glycoprotein inhibitors of TGF $\beta$  are selected from  $\alpha_2$ -macroglobulin, laminin and collagen.--

--38. The use according to claim 35 wherein the proteoglycan inhibitors of TGF $\beta$  are selected from decorin, heparan sulfate proteoglycans and biglycan.--

REMARKS

In light of the foregoing, favorable consideration of the application is respectfully requested.

Respectfully submitted,

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FULWIDER PATTON LEE & UTECHT

By: \_\_\_\_\_

John V. Hanley

Registration No. 38,171

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Enclosures

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